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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/675,443

Filing Date: September 30, 2003

Appellant(s): KARAOGUZ ET AL.

Broadcom Corporation
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 21 June 2010 appealing from the Office action mailed 25 November 2009.

(1) Real Party in Interest

The examiner has no comment on the statement, or lack of statement, identifying by name the real party in interest in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The following is a list of claims that are rejected and pending in the application:

Examiner agrees that claims 1-30 have been rejected and are appealed. The claims are correctly stated in the Appendix.

(4) Status of Amendments After Final

The examiner has no comment on the appellant's statement of the status of amendments after final rejection contained in the brief.

(5) Summary of Claimed Subject Matter

The examiner has no comment on the summary of claimed subject matter contained in the brief.

(6) Grounds of Rejection to be Reviewed on Appeal

The examiner has no comment on the appellant's statement of the grounds of rejection to be reviewed on appeal. Every ground of rejection set forth in the Office action from which the appeal is taken (as modified by any advisory actions) is being maintained by the examiner except for the grounds of rejection (if any) listed under the subheading "WITHDRAWN"

REJECTIONS.” New grounds of rejection (if any) are provided under the subheading “NEW GROUNDS OF REJECTION.”

(7) Claims Appendix

The examiner has no comment on the copy of the appealed claims contained in the Appendix to the appellant’s brief.

(8) Evidence Relied Upon

6,292,129	DYNARSKI et al.	08-2001
6,934,754	WEST et al.	08-2005

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dynarski et al. (6,272,129) in view of West et al. (6,934,754).

3. For claims 1, 11, 21, Dynarski teaches a method and system (abstract) for setting up devices for communication (col. 1, line 1 – col. 3, line 35), the method comprising:

a. in a communication network (col. 4, lines 34 – 45) comprising a headend, wherein said headend enables access to said communication network for at least a first device (Fig. 1, #22; home agent),

b. assigning, by said headend, an address to said first device coupled to said communication network (Fig. 1, #14), wherein said address is associated with said first device in said communication network at a time of said assigning (col. 5, lines 3 – 62); and

c. in response to said headend receiving an identifier of said first device from said first device, communicating, by said headend, one or both of said transferred assigned address and/or said identifier of said first device to at least one communication server coupled to said communication network (col. 6, line 55 – col. 8, line 50).

4. In Dynarski, the home agent does not initiate communication but instead handles a communication from terminal 10 wishing to connect to terminal 14 on a different network. Examiner considers the steps of assigning or associating addresses to include activities such as routing packets, address translation, and device location and authentication, which is performed by the headend.

5. Dynarski does not expressly disclose that said address is associated with said first device in said communication network at a time of said assigning, nor transferring, by said headend, said assigned address to said first device. West teaches a method and system (abstract) of setting up devices for communication (col. 1, line 1 - col. 4, line 40; col. 12, line 60 - col. 14, line 5) wherein a headend develops connections (col. 4, line 40 - col. 5, line 20) such that the assignment and association occur at the same time (col. 5, line 40 - col. 6, line 40) and wherein the headend transfers the address to the device and to the remote server (col. 7, lines 10 – 50; col. 8, lines 10 – 20; col. 9, lines 40 -55; West teaches not only the timing of association and assignment, but also transferring the address). At the time the invention was made, one of

ordinary skill in the art would have added West to Dynarski in order to improve address management (col. 2, lines 5 – 55).

6. For claims 2, 12, 22, Dynarski teaches detecting, by said headend, when said first device is initially coupled to said communication network prior to said assigning of said address to said first device (col. 4, line 45 – col. 5, line 3).

7. For claims 3, 13, 23, Dynarski teaches that said assigned address of said first device is one of a static address, a dynamic address, or an embedded device address; and said identifier of said first device is one of a digital certificate and a serial number (col. 5, lines 3 – 62; IP address, Electronic Serial Number).

8. For claims 4, 14, 24, Dynarski teaches whereto said one or both of said transferred assigned address and/or said identifier of said first device is registered with said at least one communication server (col. 6, line 55 – col. 8, line 50).

9. For claims 5, 15, 25, Dynarski teaches broadcasting said one or both of said transferred assigned address and/or said identifier of said first device throughout at least a portion of said communication network by said at least one communication server (col. 6, line 55 – col. 8, line 50).

10. For claims 6, 16, 26, Dynarski teaches receiving said broadcasted one or both of said transferred assigned address and/or said identifier of said first device by a second device located in said at least a portion of said communication network (Fig. 1; col. 4, line 45 – col. 5, line 3).

11. For claims 7, 17, 27, Dynarski teaches that said first device communicates with said second device utilizing said received broadcasted one or both of said transferred assigned address and/or said identifier of said first device (Fig. 1; col. 4, line 45 – col. 5, line 3).

12. For claims 8, 18, 28, Dynarski teaches a second device desiring to communicate with said first device via said communication network requests said one or both of said transferred assigned address and/or said identifier of said first device from said communication server (Fig. 1; col. 4, line 45 – col. 5, line 3).

13. For claims 9, 19, 29, Dynarski teaches that, in response to said request, said second device receives said one or both of said transferred assigned address and/or said identifier of said first device from said communication server (col. 6, line 55 – col. 8, line 50); and said second device transfers media between said second device and said first device utilizing said received one or both of said transferred assigned address and/or said identifier of said first device (col. 4, lines 35 – 45).

14. For claims 10, 20, 30, Dynarski teaches said second device requests said one or both of said transferred assigned address and/or said identifier of said first device from said communication server based on a known location of said first device (col. 4, line 45 – col. 5, line 62).

(10) Response to Argument

Appellant's arguments filed 21 June 2010 have been fully considered but they are not persuasive. An analysis of the arguments is provided below.

In response to appellant's argument that there is no teaching, suggestion, or motivation to combine the references (Pp. 7-8 and 16-18), the examiner recognizes that obviousness may be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the

references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988), *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992), and *KSR International Co. v. Teleflex, Inc.*, 550 U.S. 398, 82 USPQ2d 1385 (2007). In this case, the articulated reasoning does not need to be a detailed thesis as to the motivation to combine, particularly when the secondary art addresses an issue of the primary art's concern.

Dynarski is about setting up communications with devices by, at the very least, being concerned with address association and assignment, as argued in the prior office action (Final action, Paras. 9-10). Appellant concedes that Dynarski teaches at least this much (remarks, P. 11). More particularly, it is a goal of Dynarski to improve the initiation of communications (Dynarski, abstract) by better handling address management steps (Dynarski, col. 1, line 55 - col. 2, line 30). The motivation to combine comes from a person of ordinary skill in the art's motivation to seek out other solutions to this problem to learn improvements. West is also concerned with the goal of improving upon the initiating of communications (West, abstract) by improving address management (West, col. 1, line 1 – col. 4, line 40) in ways that one of ordinary skill in the art would learn from. Since West improves on Dynarski's techniques and helps solves Dynarski's problems, there is sufficient motivation to combine based upon the art's shared goals.

Appellant argues that Dynarski does not expressly disclose assigning, by said headend, an address to said first device coupled to said communication network (Pp. 8—12). In response to appellant's argument that the references fail to show certain features of appellant's invention, it is

noted that the features upon which appellant relies (i.e., the scope of the claims) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

As stated in the final action and advisory action, one must give the claims their broadest reasonable interpretation in light of the common meaning, the definitions within the specification, and the knowledge of one of ordinary skill in the art. One must also compare this area to the art as a whole, based not on the particular phrasing of the claims or art but upon the common structure and function of the claims.

In the particular case, the assigning and associating steps are interpreted as developing a relationship of any type between an address of any form and a device of any form. The claims do not specify the relationship, describe the function of the assigning step or describe how the assignment is ultimately used. Therefore, relationship may be considered broadly. This interpretation is bolstered by the definitions provided (specification, Paras. 49, 63 – 66, and 72-73). Even if we were to accept as the interpretation a narrower definition of static/dynamic IP addressing, the limitation would still be shown by relationships such as locating and identifying devices, mapping IP addresses, and performing steps to initiate communication.

In this case, the headend cannot always know the address because the device may move around or be inactive. To handle this situation, the device tells the headend a device. The headend then populates the memory of the communication server (in this case, #28 and #30), such that the headend may later retrieve and use this information to locate the device. That the servers do much of the processing is not inconsistent with the claims as currently drawn.

Appellant errs in interpreting his claims so narrowly and in not viewing the art as a whole, but instead focusing on the times when the communication server reports to the headend.

Appellant then argues that Dynarski does not expressly disclose, "in response to said headend receiving an identifier of said first device from said first device, communicating, by said headend, one or both of said transferred assigned addresses and/or said identifier of said first device to at least one communication server coupled to said communication network (Pp. 12 – 15)." Appellant is reminded that claims must be given their broadest reasonable interpretation, particularly in regards to timing. As for the length of the cited limitation, it is acceptable because it is a unified section and not unreasonable in length. There is no requirement that the examiner is limited to only a paragraph or column.

Again, appellant seems to be under the impression that, despite the device interacting only with the headend, the communication server acts on its own. In doing so, appellant glosses over communications from the headend to the server, i.e. the access-request message that includes transferred assigned addresses and/or identifiers. Without this request, the server would never provide an accept or response message, let alone one with the information the headend desires. This message is in response to the device because the headend makes the request in response to a communication from the device, i.e. a request for connection that includes the information.

Appellant then argues that West does not expressly disclose both the transferring step and the assigning step (Pp. 16 - 17).

In response to appellant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Therefore, West does not have to teach the full assigning step.

In response to appellant's argument, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). The fact that the assigning component is separate from the translating component does not mean that the system cannot be combined with respect to the timing of the situation.

Appellant's argument depends on the failure to recognize that the assignment occurs either as part of translation or not. The claim language states that the headend transfers an address to the device after the assignment step and in response to seeing an identifier. If the device is on a new assignment track, this is clearly shown and the step of translation is not needed. If the computer already has an IP address, the translation acts as the assigning and associating step (col. 5, line 60 - col. 6, line 40).

Regarding claim 2, appellant argues that Dynarski does not expressly disclose that detecting occurs prior to the assigning, but rather occurs afterwards (Pp. 18 - 20). In this case, appellant misapplies the understanding of the communication; just because a device sends an IP

packet does not mean that the assignment has occurred. In fact, the next steps after the home agent receives the packet appellant mentions is that it detects whether it has a mobility binding record and acts accordingly by moving to the detection phase and then to the assignment phase (col. 6, line 55 - col. 7, line 60).

Appellant makes a similar argument regarding claims 6 (P. 23), 8 (P. 25), 9 (P. 26), and 10 (P. 27). Examiner upholds his argument for the same reason.

Regarding claims 4, 5, 9, and 10, appellant argues that the examiner's burden to explain how a passage is disclosed by a reference cannot be met if an examiner cites to an unreasonably lengthy passage of 1.5 columns long (Pp. 20 – 22, 25-27). The examiner agrees that the requirement requires clarity but there is no ruling that any particular citation length is *prima facie verboten*, particularly if the entire cited section is focused on one area of detail. Appellant has not shown any indication that he has attempted to read the passage, let alone that there was any confusion as to which structure or function the examiner was referring to. At any rate, the cited passage is only eight paragraphs long and is only a small portion relative to the size of the art. More pertinent is that every paragraph deals in some way with the limitation of registering addresses with the communication server. If the board were to add a length restriction to examiner analysis, it would keep examiners from citing all the relevant evidence of obviousness and keep examiners from discussing the art as a whole.

Regarding claims 6-8, appellant makes the same argument in regards to a lengthy passage of one paragraph (Pp 22-25). The appellant argues that a single paragraph citation for a claim with a single limitation warrants a detailed analysis by the examiner to connect the dots. As

shown above, the test is not whether the passage is too long or the examiner's citations are too short but whether the application is clear. Here, the passage clearly shows a second device receiving information about a first device, and therefore needs no further clarification on how to apply the paragraph.

The board should uphold the above rulings for the reasons above.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Melvin Pollack

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